

REMARKS/ARGUMENTS

In an Office Action mailed May 17, 2004, the Examiner rejected all pending claims 1-20. The Examiner rejected claims 1-16 and 18-20 as allegedly unpatentable under a nonstatutory doctrine of double patenting in light of various claims of U.S. 6,726,300 (Schloeman, et al.) and rejected claims 1-7, 9-13 and 15-19 as allegedly unpatentably obvious over EP 1080898 A2 (Saul) in view of U.S. 6,186,611 (Shiraishi) and U.S. 5,751,302 (Rezanka). For the following reasons, Applicants respectfully request that the Examiner withdraw all of the rejections of claims 1-20, enter new claims 21-26 and allow all claims 1-26.

Obviousness:

In the Office Action, the Examiner rejected claims 1-7, 9-13 and 15-19 as allegedly unpatentably obvious Saul in view of Shiraishi and Rezanka. Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with respect to any one of claims 1-7, 9-13 or 15-19 because none of the cited references disclose, teach or suggest all of the limitations of any one of the rejected claims.

No Motivation to Combine Saul with Shiraishi:

The Examiner has failed to establish a prima facie case of obviousness at least because he has failed to provide evidence of a motivation to combine Saul with Shiraishi.

In the Office Action, the Examiner stated that the motivation to combine Saul with Shiraishi was to, "provide a gradation record control apparatus for an ink jet printer which can achieve a high-speed gradation printing as taught by Shiraishi" Applicants respectfully submit that the Examiner failed to establish a motivation to combine the "gradation record control apparatus" of Shirashi with Saul.

Saul recites "a plurality of heater resistors" Para. [0027]. Shiraishi recites a "gradation record control apparatus for an ink jet printer" (2:41-42)

where the ink jet printer includes "an ink chamber filled with a conductive ink, and 3 and 4 a pair of electrodes." 3:42-43. "[W]hen the conductive ink in the periphery of the electrodes 3 and 4 is to be jetted, the high and low levels of the pulse signals I and j respectively are alternately repeated for a predetermined period and an AC current is flown between the electrodes 3 and 4." 4:11-14.

Shiraishi does not disclose, teach or suggest "firing resistors," as recited in all of claims 1-7, 9-13 and 15-19. Nor has the Examiner provided any evidence to support combining Saul, which describes "heater resistors" with Shiraishi, which recites "conductive ink." Applicants therefore request that the Examiner withdraw the rejections of claims 1-7, 9-13 and 15-19.

Double Patenting:

In the Office Action, the Examiner rejected claims 1-16, 18-20 as allegedly unpatentable under a nonstatutory doctrine of double patenting in light of various claims of U.S. 6,726,300 (Schloeman, et al.). A terminal disclaimer is filed concurrently herewith. Applicants respectfully submit that the double patenting rejection is moot and should be withdrawn.

New Claims:

Applicants respectfully request that the Examiner enter new claims 21-28. Applicants respectfully submit that the new claims are supported in the specification as filed, at least at claims 1 and 15 and page 14, line 30 through page 15 line 8 and Figure 6. Applicants respectfully submit that the new claims are patentable over the cited references at least because there is no motivation to combine Saul with Shiraishi.

CONCLUSION

For the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejections of all claims 1-20, enter new claims 21-28 and allow claims 1-28.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter Reitan', with a long horizontal stroke extending to the right.

Dated: 8/12/04

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